REMARKS

- Claims **1 – 26 and 37** are currently pending, and will remain pending upon entry of this amendment.
- Claim **38**, a dependent claim, has been added herein.
- Claims **1, 19, 22 and 37** (which constitute all of the pending independent claims) have been amended herein.

1. Specification

The Examiner helpfully pointed out that the specification contained an typographical error – on page 5, line 28, the word "by" has been changed to the word "be", as suggested by the Examiner.

2. Drawings

The Examiner has required that the drawings be amended to explicitly include all of the features of claims **6 – 37**. Applicants have added FIGS. 8 – 29 (via new sheets) and correspondingly amended the brief description of the drawings in the specification, in compliance with the Examiner's requirement. Applicants note, with respect to claims **6 – 18** that the features of these claims are believed to already be sufficiently shown in the drawings as originally filed, as these claims merely provide further definition for a feature of independent claim 1, which is illustrated in Fig. 7. However, to explicitly and fully comply with the Examiner's request, Applicants have added flowcharts that explicitly illustrate each of the respective features of these claims.

3. Claim Rejections – Section 102

Claims 1 – 5 and 8

Claims **1 – 5 and 8** stand rejected under 35 U.S.C. §102(b) as being anticipated by *Fey, Slot Machines, a Pictorial History of the First 100 Years* ("Fey" herein). Applicants respectfully traverse this rejection.

Applicants have amended claim **1** to explicitly claim an embodiment of the present invention. Specifically, Applicants have amended claim **1** to further define what a game parameter means for purposes of the claimed embodiment:

- *determining a game parameter, the game parameter serving to control at least one element of a game such that it affects a manner in which the game will be conducted; and*
- *[after an actual value for the game parameter has been set] controlling the at least one element of the game using the actual value such that the manner in which the game is conducted subsequent to the setting of the actual value is affected by the actual value*

The subject matter of this amendment is fully supported by the specification. See, for example, page 26, lines 17 – 22 and page 34, line 22 through page 36, line 13.

Fey does not teach or suggest the above feature(s). In Fey, no value is determined for *a game parameter that serves to control at least one element of a game such that is affects a manner in which the game will be conducted.*

It is Applicants understanding that the Examiner is interpreting Fey as teaching that a payout to be determined for a handle pull is a game parameter and the actual value of the payout determined for the handle pull is the actual value of the game parameter. Current Office Action, page 3.

Applicants respectfully request that the Examiner provide further explanation of the Examiner's interpretation of Fey if Applicants' understanding is incorrect and / or incomplete. The following arguments are provided based on the assumption that Applicants' understanding of the Examiner's interpretation is correct.

Fey does not teach the above-quoted claim features because a payout determined for a game play does not affect *a manner in* which a game will be conducted. At most, all or a portion of the payout may be used, at a player's discretion, to wager on a subsequent handle pull. Thus, a payout from a previous handle pull may in some circumstances be a source for providing a wager for a subsequent handle pull but the payout itself in no way affects a manner in which a game will be conducted. It may be argued that a wager may affect a manner in which a payout will be affected in the sense that a wager of a first magnitude may provide access to a first payout while a magnitude of a second magnitude may provide access to a second payout. However, a magnitude of a wager provided for a handle pull is not equivalent to a payout from a prior handle pull. The wager is a distinct element in game play, determined solely by a decision of a player. At most, the payout from the prior game play may be added to a fund available to a player for wagering. However, it is not the payout from the prior handle pull that is a wager for the subsequent handle pull. Accordingly, Applicants respectfully submit that claim 1, and thus claims **2 – 18** (which are dependent from claim **1**), are patentable over Fey.

Claims 19 – 26 and 37

Claims **19 – 26 and 37** stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,068,552 to Walker et al. ("Walker" herein).

Applicants have amended claim **19, 22 and 37** (the only dependent claims in this set of rejected claims) to define that the value of the game play parameter is *determined based on a random number*. Walker's description of a player being able to choose any game play parameter value is counter to this claimed feature: in Walker the player selects the game play parameter value. The game play parameter value is not determined based on a random number, which would take away the player's control over the determination.

Further, Applicants respectfully submit that claims **19 – 26 and 37** are patentable over Walker even prior to the amendment made herein because the entity in the claimed embodiments that is randomly determining the game play parameter value is not the player. The claims are written from a device (e.g., gaming device or controller) perspective such that the steps of the methods are not performed by the player. This is evident at least because a signal is *received from a player* in the claims. Thus, the entity performing the steps cannot be the player. Thus, even under the Examiner's interpretation of Walker as teaching that a player may choose any game play parameter value, thus rendering the game play parameter to be determined at random (Current Office Action, page 4), does not in an way anticipate or render obvious a process wherein an entity other than a player determines a game play parameter at random. In Walker, the entity other than the player that determines the value of a parameter (e.g., a gaming device) does so specifically based on the player's selection (or based on a calculation that

includes the player's selection) and does not determine it at random in any sense.

Applicants thus respectfully submit that claims **19** (as well as **20** and **21**, dependent from **19**), **22** (as well as **23 – 26**, dependent from **22**) and **37** are patentable over Walker for the reasons set forth above.

4. Claim Rejections – Section 103

Claims **6, 7 and 9 – 18** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fey in view of Walker and "Applicant's disclosure." Specifically, the Examiner has asserted that "Applicants teach that all of these various game parameters [of claims 6, 7 and 9 – 18] are equivalent." Current Office Action, page 6. Applicants respectfully traverse this rejection for the reasons set forth below.

First, Applicants are confused as to the relevancy of what Applicants have disclosed. While an Applicant's admission that the work of another is "prior art" may in some circumstances be used as a basis for an obviousness rejection (see MPEP 2129), the mere fact that Applicants have disclosed something in their specification is irrelevant to an obviousness determination. Allowing something an Applicants merely discloses in an application to be used as a basis for an obviousness rejection would effectively allow the Applicants specification to be used as a blueprint for piecing together the prior art, which is contrary to law. See, for example, In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998) and In Re Lee, 227 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002)(" It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its

teacher."). The Examiner has not made any assertion that Applicants in any manner admitted that it was recognized in the *prior art* that the elements of claims **6, 7 and 9 – 18** were considered to be equivalent.

Second, Applicants have reviewed the entirety of the specification as filed and have failed to find any statement that the elements of claims **6, 7 and 9 – 18** are equivalent. Applicants respectfully request that the Examiner point to a specific section of the specification for support of this assertion.

Third, Applicants respectfully submit that the Examiner's motivation for combining Fey, Walker and "Applicants' disclosure" is improper because it would not have lead one of ordinary skill in the art to make the specific claimed invention and is insufficient to satisfy the Examiner's burden of presenting a prima facie case of obviousness.

The Examiner has asserted that it would have been to have made the combination "in order to induce players to continue playing for extended periods of time." The mere fact that references can be combined or modified or that a desirable result may be obtained from combining or modifying references is not sufficient to meet Examiner's burden. Further, the mere recognition of a need for a solution to a broad problem does not render obvious a particular solution to that problem. "Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure." Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 381 F.3d 1371 (Fed. Cir. 2004).

Finally, Applicants respectfully submit that claims **6, 7 and 9 – 18** are patentable over Fey in view of Walker and further in view of "Applicant's"

disclosure at least for the same reasons as claim **1**, by virtue of being dependent therefrom and including all of the limitations thereof.

CONCLUSION

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at mfincham@walkerdigital.com.

Applicants do not believe any fee (e.g., for an extension of time with which to respond to the Office Action) is required at this time. However, if a fee should be necessary for the present Application at this time (or any time during the prosecution of the present Application), please charge any such required fee to our Deposit Account No. 50-0271. Further, if a petition for an extension of time with which to response to an Office Action is required, please grant such petition. Please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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